

REMARKS

Status of Claims

Claims 1-17 and 35-38 are pending. Claims 18-34 have been withdrawn.

Piecemeal Examination

Applicants must point out here that despite several previous rounds of substantive examination the Examiner has now issued a new set of rejections. Applicants refer to MPEP 707.07(g), which states in part:

Piecemeal examination should be avoided as much as possible. The examiner ordinarily should reject each claim on all valid grounds available, avoiding, however, undue multiplication of references.

All valid and available grounds for objection / rejection were *not* presented in the first Office Action. As a result, minimal (if any) progress has been made in the substantive prosecution of this case following Applicants' November 2, 2006 paper. Applicants' rights have been unfairly prejudiced by this delay. To avoid further delay and prejudice, Applicants respectfully request that all issues remaining in this application be handled completely, and that the Examiner consider this paper promptly.

Examiner's Grounds for Rejection

Claims 1-17 and 35-38 are rejected under 35 USC §103 as allegedly being obvious in view of US2003/0144252 ("Furr"). Applicants traverse.

Applicants have carefully studied the variety of formulations containing the subject compounds, as shown in the examples and disclosure of the specification, and have made the discovery that it is necessary to form a composition with a pH of at least 8 to achieve the desired increased stability.

The Examiner admits in the Office Action that Furr fails to teach or suggest anything relating to pH (see, e.g., Office Action at page 3: "...the reference is silent about the pH of the composition..."). It is also the case that Furr says nothing regarding stability, or the need for stabilization. Additionally, other than for the overall (total) amount of excipients, Furr fails to include any direction whatsoever relating the actual useful amounts, combinations or relative

proportions of excipients, much less *preferred* amounts, combinations or proportions. Furr does not disclose a single real world example, or even a prophetic example, showing useful amounts, combinations or relative proportions of excipients. Therefore, considering paragraph [0034] of Furr, one skilled in the art would not be taught to select calcium carbonate (or any other basic excipient) from amongst the many listed excipients, and would not be taught to use calcium carbonate in an amount sufficient to achieve pH 8 or greater. That is, contrary to the Examiner's unsupported statement in the last paragraph of the Office Action, there is no motivation to select the excipient calcium carbonate.

Similarly, one skilled in the art would not be taught to select EKB-569 from amongst the many listed EGFR compounds. In fact, as most discussion in Furr related to the compound ZD1839 (see, e.g., paragraphs [0025], [0037], [0038], [0039], [0040] and [0041]), contrary to the Examiner's unsupported statement in the last paragraph of the Office Action, there is no motivation to select the EKB-569, while there is in fact a "teaching away" from such a selection in favor of selecting ZD 1839.

The Examiner argues that the excipients are taught in an amount of from 5-98%, and that even 5% calcium carbonate would achieve pH of greater than 8. This argument ignores the facts, as well as the law of obviousness.

Factually, the Furr reference discuss the use of an "amount of excipients", meaning that a single pharmaceutical composition described Furr may include numerous excipients. In view of the total lack of direction regarding excipients noted above, one skilled in the art certainly would not be taught the use of a *single* excipient in an amount of 5% or more.

Legally, the Examiner cited *the teachings of the instant specification* to support the proposition that a skilled chemist would find the claimed invention obvious (see, e.g., Office Action at pages 3-4). This is nonsensical, as the skilled chemist would not have had the benefit of the instant specification when considering the Furr reference. The Examiner is engaging in inappropriate hindsight reasoning to form the basis for his section 103 obviousness rejection, and so the Examiner's position citing what "the instant specification teaches" cannot appropriately be maintained.

Finally, the Examiner ignores the fact that Furr relates to a combination composition comprising two active agents. This is important for two reasons. First, a reference teaching a two active ingredient composition does not teach or suggest the claimed one active agent composition, and in fact teaches away from the claimed composition. Second, the other

active agent – the nonsteroidal anti-androgen – is itself likely to have a pH modifying effect that alters the pH modifying effect of any excipient, with the result being a skilled chemist is taught nothing about the pH of the claimed composition from Furr.

In view of the arguments presented above Applicants respectfully request reconsideration and withdrawal of the §103 rejection based on Furr.

For the foregoing reasons, Applicants respectfully request reconsideration and withdrawal of all pending rejections, and prompt issuance of a Notice of Allowance.

If any issues remain after consideration of this Amendment, the Examiner is urged to contact the undersigned by telephone at 845-602-4760.



David A. Rubin
Attorney for Applicants
Reg. No. 40,314

Wyeth
Patent Law Department
Five Giralda Farms
Madison, NJ 07940
Tel. No. (845) 602-4760